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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,195	03/11/2004	Stephen Gold	1509-219A	4728

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EXAMINER

ST CYR, DANIEL

ART UNIT PAPER NUMBER

2876

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,195

Applicant(s)

GOLD ET AL.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 14-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 14-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/937,021.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/11/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/937,021, filed on 09/20/01. *Specification*

2. The specification of the disclosure is objected to because the applicant failed to provide the continuation data, the continuation information should be on the first page, first line of the specification. Correction is required.

Claim Objections

3. Claim 38 is objected to because of the following informalities: the claim is read "Claim 36.", it should read --Claim 38.--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 14-19, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al, US, 5,455,409, cited by the applicant, in view of Ruppert et al, US Patent No. 5,640,002.

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Smith et al disclose an apparatus and method for monitoring a plurality of coded articles and for identifying the location of selected articles comprising: a computer 52 having a communication converter 62 for receiving data signals from data storage devices 10 within the carriers 12 (see col. 17, line 4), a memory means capable for storing said data signals received from the converter 62 (see col. 14, line 25), the computer inherently includes a controller/processor for controlling the functions of the apparatus (see figures 6, 8A-D; col. 10, line 3+; col. 14, line 18+).

Smith et al disclose identification code is printed on labels attached to the tape cartridges (see col. 8, line 24), but fail to disclose a printer attached to the hand-held reader device for printing the identification code.

Ruppert et al disclose a portable RF ID tag and bar code reader comprising: a body 302; a card slot 300; an antenna 304 coupled to an RF module; a display unit 308; a printer 310; a microcomputer 320; an RF/ID reader 314; contact smart card interface 514 and non-contact smart card interface 517; etc. (see figures 16-19).

In view of Ruppert et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Smith et al to include a portable hand-held reader having a printer therein for monitoring, programming, and printing labels for the cartridges. Such modification would make the system more effective wherein the mobile unit could be held/placed at various positions to receive optimal signals. Further, such modified system would be very compact, which would facilitate operators interaction with the unit to obtain greater transactions output. Therefore, it would have been an obvious extension as taught by Smith et al.

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Re claims 15-18 and 31-34 since structural limitations are as recited, the method step is obtained, and therefore, obvious.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 14-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,776,343 (hereinafter '343 Patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed invention is somehow a broader recitation of the '343 Patent. For instance, in claim 1 of the present invention and the '343 Patents claim:

i)"A hand holdable portable reader device capable of reading data stored in a memory device attached to a cartridge having data storage device therein, said reader device comprising:

a signal receiver means capable of receiving data signals emitted from said memory device;

a memory means capable of storing said data signals received by said receiver means;

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a printer device configured to print human readable indicia determined by at least some of said data signals received by the printer device from said receiver means onto a print media; and

a processor device operable to control said printer device to print said indicia on said print media.”, where in the ‘343 Patent, the applicant claim;

ii)” A hand holdable portable reader device capable of reading data stored in a memory device attached to a cartridge having data storage device therein, said reader device comprising:

a signal receiver means capable of receiving data signals emitted from said memory device;

a memory means capable of storing said data signals received by said receiver means;

a printer device configured to print human readable indicia determined by at least some of said data signals received by the printer device from said receiver means onto a print media; and

a processor device operable to control said printer device to print said indicia on said print media, said processor device being configured to select a predetermined selection of information items describing said data storage device from said data received from said memory device, and to control said printer device to print said predetermined set of information items onto a said print media in a predetermined format.”

The ‘363 patent meets all the limitations of the claims 1 and 14-38.

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims ‘343 Patent as a general teaching for reading memory devices, to perform the same function as claimed in the present invention. The

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instant claims obviously encompass the claimed invention of the '343 Patent and differ only in terminology. The extent that the instant claims are broaden and therefore generic to claimed invention of '343 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from the claims in a first patent. IN re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. & 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. & 1.78(d).

Allowable Subject Matter

8. Claims 20-30 and 35-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and upon filing of a terminal disclaimer.

9. The following is a statement of reasons for the indication of allowable subject matter: Although the prior art of record teaches a system that uses portable reader device for printing labels to be placed onto cartridges, the prior art of record fails to disclose or fairly suggests all the details and functions of the reader, including a processor for selectively causing the memory to couple at least one of the received and stored data signals to the printer, said printer being adapted to be activated so said label includes in user readable format information, etc. These

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limitations in conjunction with other limitations in the claim were shown by the prior art of record.

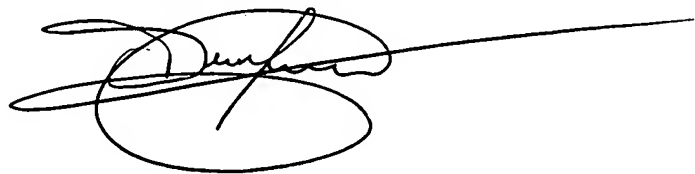
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', is written over a large, loopy circular flourish.

DS
November 16, 2004